

Appl. No. 10/738,474
Examiner: NGUYEN, LEE, Art Unit 2618
In response to the Office Action dated September 11, 2006

Date: December 11, 2006
Attorney Docket No. 10113521

REMARKS

Responsive to the Office Action mailed on September 11, 2006 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

Present Status of Application

Claims 1-3, 6-11, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al (US 5,722,055, hereinafter "Kobayashi"). Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of Hietanen (US 2002/0076041). Claims 4-5 and 12 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

In this paper, claim 1 is amended to include all the limitations of claim 4. Claim 5 is amended to depend from claim 1. Claim 9 is amended to include all of the limitations of claim 12. Claim 13 is amended to include the limitations of claim 14. Claim 17 is amended to recite that the microphone is abutted by the front case. Support for this amendment can be found, for example, on page 9, lines 1-4 of the specification. Claims 4, 12 and 14 are canceled. Thus, on entry of the amendment, claims 1-3, 5-11, 13, and 15-20 remain in the application.

Reconsideration of this application is respectfully requested in light of the amendments and the remarks contained below.

Allowable Subject Matter

Applicant thanks the Examiner for his indication in the Office Action that claims 4, 5 and 12 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

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Insofar as claims 1 and 9 have been amended to include all the limitations of claims 4 and 12, respectively, they are believed to be in condition for allowance. Furthermore, claims 2-3, 5-8, and 10-11 are believed to be allowable at least by virtue of their dependency from either claim 1 or claim 9.

Rejections Under 35 U.S.C. 102(b)

Claims 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi. To the extent that the grounds of the rejections may be applied to the claims now pending in this application, they are respectfully traversed.

The rejection of a claim for anticipation under 35 U.S.C. §102 requires that the prior art reference include every element of the rejected claim. Furthermore, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention "arranged as in the claim." *Lindermann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

Kobayashi does not teach or suggest that the microphone is abutted by the front case, as recited in claim 17.

Amended claim 17 recites an electronic device comprising a housing, a printed circuit board, a connector, and a microphone. The housing includes a front case. The printed circuit board is disposed in the housing. The connector is fitted into the printed circuit board. The microphone is disposed in the connector in a manner such that the microphone faces the front case. In addition, the microphone is abutted by the front case.

Kobayashi discloses a portable telephone 11 comprising a front case assembly 25, a front printed-circuit board assembly 41, a microphone bushing 41-11, and a microphone unit 21. The microphone bushing 41-11, shown in FIG. 10, is used to mount the microphone unit 21 on the printed-circuit board 41-1. The microphone bushing 41-11 with the microphone unit 21 inserted

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therein is attached to the printed-circuit board 41-1 by fitting a recessed portion 41-11-1 into the U-shaped cut-out portion 41-1-3 (column 6, lines 57-63). Specifically, in FIG. 10, the microphone unit 21 is illustrated by dash-lines.

In the rejections, the Examiner identifies Kobayashi's microphone unit 21 and front case assembly 25 as the alleged "microphone" and "front case" of claim 17. However, as shown in the figures, the microphone unit 21 is received into the interior of the microphone bushing 41-11, and the microphone bushing 41-11 is abutted by the front case assembly 25. Thus, contrary to the invention recited in claim 17, the microphone unit 21 is not abutted by the front case assembly 25.

For at least the reasons described above, it is Applicant's belief that the cited reference fails to teach or suggest all the limitations of claim 17. Applicant therefore respectfully requests that the rejection of claim 17 be withdrawn and the claim passed to issue. Insofar as claims 18-20 depend from claim 17 either directly or indirectly, and therefore incorporate all of the limitations of claim 17, it is Applicant's belief that these claims are also in condition for allowance.

Rejections Under 35 U.S.C. 103(a)

Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of Hietanen. To the extent that the grounds of the rejections may be applied to the claims now pending in this application, they are respectfully traversed.

MPEP 2142 reads in part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

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claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In connection with the third criteria, MPEP 2143.03 goes on the state:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Amended claim 13 recites a mobile phone comprising a housing, a printed circuit board, and a microphone. The housing includes a front case. The printed circuit board is disposed in the housing, and includes a notch and a circuit. The microphone includes a pad, and is fitted into the notch of the printed circuit board in a manner such that the microphone faces the front case. The pad is electrically connected to the circuit, and is abutted by a surface, facing the front case, of the printed circuit board.

As noted above, in Kobayashi, the microphone bushing 41-11 includes the recessed portion 41-11-1 that is fitted into the U-shaped cut-out portion 41-1-3 of the printed-circuit board 41-1. However, the microphone unit 21 does not include a pad.

Hietanen discloses a method for fixing the substrate of an acoustic transducer. However, Hietanen does not disclose that the microphone includes a pad.

It is therefore Applicant's belief that even when taken in combination, the prior art references relied upon by the Examiner do not teach or suggest all the limitations of claim 13. For at least this reason, a *prima facie* case of obviousness cannot be established in connection with these

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claims. Furthermore, as it is Applicant's belief that a *prima facie* case of obviousness is not established for claim 13, the Examiner's arguments in regard to the dependent claims are considered moot and are not addressed here. Allowance of claims 13-16 is respectfully requested.

Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so.

Respectfully submitted,



Nelson A. Quintero

Reg. No. 52,143

Customer No. 34,283

Telephone: (310) 401-6180

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